UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,549	10/17/2000	Oleg B. Rashkovskiy	INTL-0476-US(P10023)	2613

7590 02/03/2004

Timothy N. Trop
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Ste. 100
Houston, TX 77024

EXAMINER	
DEMICCO, MATTHEW R	

ART UNIT	PAPER NUMBER
2611	2

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/690,549	RASHKOVSKIY, OLEG B.	
	Examiner	Art Unit	
	Matthew R Demicco	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☒ Claim(s) *38* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 October 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 2, Element 64. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claim 38 is objected to because of the following informalities: Claim 38 is written to depend from Claim 35 when it appears to more properly depend from Claim 36. For examination purposes, it will be treated as depending from Claim 36. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 9-16 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,815,671 to Morrison.

Regarding Claim 1, Morrison discloses a method comprising storing an advertisement (Col. 3, Lines 28-32) for playback with content (Col. 3, Lines 34-43).

Morrison further discloses automatically replacing the stored advertisement (Col. 2, Lines 55-67 and Col. 6, Lines 26-42).

Regarding Claim 2, Morrison discloses a method as stated above in Claim 1 wherein storing an advertisement for playback with content includes storing an advertisement in a separate memory location from the content (Col. 3, Lines 28-32).

Regarding Claims 3 and 4, Morrison discloses a method as stated above in Claim 1 including providing a marker in the content to indicate where the advertisement should be inserted (See Figure 4A and Col. 3, Lines 39-63). This marker contains a message code flag for identifying the message material to be inserted and is used to find the material stored on the receiver. This reads on the claimed provision of a pointer with the marker to locate the advertisement in memory.

Regarding Claim 5, Morrison discloses a method as stated above in Claim 4 including playing back stored content (Col. 4, Lines 55-61), identifying the marker (Col. 7, Lines 16-20) and accessing the advertisement using the pointer (Cols. 7-8, Lines 66-4) as stated above.

Regarding Claim 9, Morrison discloses a method as stated above in Claim 1. Morrison further discloses updating stored advertisements (Col. 2, Lines 55-60).

Regarding Claim 10, Morrison discloses a method as stated above in Claim 9 wherein commercial messages are grouped together and transmitted to the receivers a number of times during the day (Col. 6, Lines 26-29). It is inherent that the receiver be adapted to determine when the messages are to be transmitted so it can record them. This

reads on the claimed obtaining information about when to update stored advertisements and automatically updating the ads in accordance with the information.

Regarding Claim 11, Morrison discloses a method as stated above in Claim 9. As stated above, the commercial messages are "transmitted at a number of convenient times through a 24 hour day." This reads on the claimed periodically, automatically updating the stored advertisements.

Regarding Claims 12-16 and 20-22, see Claims 1-5 and 9-11 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6-8, 17-19, 27-29, 33-38 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison in view of U.S. Patent No. 6,425,127 to Bates et al.

Regarding Claim 6, Morrison discloses a method as stated above in Claim 1. What is not disclosed, however, is determining whether an advertisement to be stored was previously stored. Bates discloses a method for transmitting and storing commercial messages at a user's receiver (See Abstract) wherein a determination is made whether an advertisement to be stored was previously stored (Col. 4, Lines 48-53). If the advertisement was not previously stored, the advertisement is stored. Bates is evidence that ordinary workers in the art would appreciate the benefit of storing only those

advertisements that have not yet been stored. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Morrison with the determination of Bates in order to only store ads that have not previously been stored in order to reduce bandwidth usage or disk I/O requirements.

Regarding Claim 7, Morrison in view of Bates disclose a method as stated above in Claim 6. It is inherent in such a system as stated above that a list of stored advertisements must be kept and new advertisements must be compared to the list in order to make a determination of whether an ad was previously stored. This reads on the claimed maintaining a list of stored advertisements and comparing information about a new advertisement to information about advertisements listed on the list.

Regarding Claim 8, Morrison in view of Bates disclose a method as stated above in Claim 7. Bates teaches storing an advertisement if it was not previously stored as stated above.

Regarding Claims 17-19, see Claims 6-8 above.

Regarding Claims 27-29, see Claims 6-8 above.

Regarding Claim 33, see Claims 1 and 6 above.

Regarding Claims 34 and 35, see Claims 7 and 8 above.

Regarding Claims 36-38, see Claims 33-35 above.

Regarding Claim 40, Morrison discloses a system as stated below in Claim 39. Morrison in view of Bates disclose a system as stated above in Claim 29.

Regarding Claim 41, Morrison in view of Bates disclose a system as stated above in Claim 40. It is inherent in such a system as stated above that a list of stored

advertisements must be kept and new advertisements must be compared to the list in order to make a determination of whether an ad was previously stored. This reads on the claimed maintaining a list of stored advertisements and comparing information about a new advertisement to information about advertisements listed on the list.

Regarding Claim 42, see Claim 40 above.

5. Claims 23-26, 30-32 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison.

Regarding Claims 23 and 25, Morrison discloses a system comprising a processor-based device (See Figure 2) wherein advertisements and content are stored in separate memory areas of a memory coupled to the processor-based device (28) as stated above. Morrison discloses only a single memory device. This reads on the claimed first random access storage to store content and the second random access storage to store an advertisement for playback with content. Further, it is inherent that any such processor-based device must execute a software code to operate and that this software code must reside in a memory. One function of this software code is to enable the device to automatically replace the stored advertisements as stated above. What is not disclosed, however, is a third random access storage for storing these instructions. Official Notice is hereby taken that it is well known in the art that a single memory device may store multiple different sets of data including program instructions and content data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Morrison with the memory of the well-

known prior art to store programming code, television content and advertising in a single memory in order to reduce costs. This reads on the claimed first, second and third storages being part of the same memory.

Regarding Claim 24, Morrison discloses a system as stated above in Claim 23. Morrison further discloses a system comprising a television broadcast receiver (Col. 5, Lines 1-14) with a tuner, memory and a processor (See Figure 2). What is not disclosed, however, is that the receiver is a set top box. Official Notice is hereby taken that it is well known in the art to use a set top box format for a television tuner with expanded functionality over a television. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the system of Morrison in the set top box of the well-known prior art in order to implement the invention on ordinary television systems.

Regarding Claim 26, Morrison discloses a system as stated above in Claim 23. Morrison further discloses the provision of a marker in the content to indicate where an advertisement should be inserted during playing of the content as stated above in Claim 3. It is inherent that there must be programming adapted to utilize this functionality and that it would be stored in the memory device as stated above.

Regarding Claims 30 and 31, see Claims 10 and 11 above.

Regarding Claim 32, Morrison discloses a system as stated above in Claim 23 including a connection to a television distribution system (Col. 4, Lines 37-61).

Regarding Claim 39, see Claim 23 above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 6,415,437 to Ludvig et al. discloses an EPG with video advertising wherein the advertising data is stored in a separate memory from the content data (EPG data).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

mrd
January 13, 2004

HAI TRAN
PATENT EXAMINER